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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,789	09/12/2001	Charlie Ricci	018413-378	8809

7590 03/13/2002  
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EXAMINER

SHARAREH, SHAHNAM J

ART UNIT PAPER NUMBER

1617

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/954,789

Applicant(s)

RICCI ET AL.

Examiner

Shahnam Sharareh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

Claims 16-19 are pending in this application.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Evans et al US Patent 5,702,361.

The instant claims are directed to kits comprising a fluid composition which forms a coherent mass in the presence of blood, a catheter suitable for delivering the fluid composition, an endovascular prosthesis, and a catheter suitable for delivering the endovascular prosthesis.

Evans discloses kits for practicing methods of treating vascular lesions comprising a fluid composition capable of forming a fluid mass in the presence of blood, an endovascular prosthesis such as a metal microcoil, and two different size catheters for delivery of the composition and the microcoil (see abstract; col 4, lines 26-47; col 10, lines 31-41; col 11, lines 52-67; col 13, lines 1-43). Accordingly, Evans anticipates the limitations of the instant claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanabe et al US Patent 5,443,454 (Tanabe) in view of Evans et al US Patent 5,695,480.

Tanabe teaches embolectomy catheters for introduction of a liquid substance (abstract). Tanabe also teaches methods of using such catheter wherein a liquid substance is administered through the catheter into an aneurysm sack wherein the liquid solidifies (see col 11, lines 13-67; col 13, lines 44-60; col 14, lines 6-35). Tanabe further teaches the catheter for embolectomy can also be used in prosthesis methods in lumen (see col 5, lines 60-67). Tanabe does not explicitly teach a kit for practicing embolectomy containing a prosthesis.

Engelson teaches methods of treating aneurysm comprising employing a prosthesis such as a vaso-occlusive devices wherein a metallic colic is entered into an aneurysm sack and administering a polymeric material in said aneurysm sack to bind the vaso-occlusive device (see col 8, lines 10-67; col 10, lines 20-49). Engelson does not specifically teach embolizing compositions that solidify upon contact with blood.

Evans teaches compositions that can solidify in the aneurysm sack upon contact with blood (abstract; col 9, lines 28-45). As taught by Evans, preparing a kit comprising all components necessary to administer an embolic composition into an aneurysm site is well within ordinary level of one of skill in the art (see col 4, lines 19-35; claims 31-46).

Accordingly, although Tanabe does explicitly not teach a kit comprising all components for practicing embolectomy, it would have been obvious to one of ordinary

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skill in the art at the time of invention, to prepare a kit comprising Tanabe's liquid substance, and Tanabe's catheter, with a prosthetic device such as those taught by Engelson, because as taught by Tanabe's patent itself, the catheter can be employed in a prosthesis method for surgical treatment of an aneurysm. Furthermore one of ordinary skill in the art would have been motivated to prepare surgical kit, such as those taught by Evans, to facilitate convenience and ease of accessibility to surgical components in a clinical setting

### ***Conclusion***

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 703-306-5400. The examiner can normally be reached on 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.



Shahnam Sharareh, PharmD  
Patent Examiner, Art Unit 1617